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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,632

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Yukimitsu Suda

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EXAMINER

SULLIVAN, DANIELLE D

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/540,632	Applicant(s) SUDA ET AL.	
	Examiner DANIELLE SULLIVAN	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 7-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 7-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

Claims 1 and 7-12 are pending. Claims 1 and 10-12 have been amended.

Withdrawn rejections

Applicant's amendments and arguments filed 8/27/2009 are acknowledged and have been fully considered. Any rejection and/or objection not specifically addressed below are herein withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakane et al. (US 5,122,418) in view of Kobayashi et al. (US 5,928,660).

Applicant's Invention

Applicant claims a complex powder comprising a lipophilic base powder and zinc oxide, where the surface of lipophilic base powder is covered with zinc oxide and an oil component wherein said complex powder is dispersed and swelled in said oil component, the zinc oxide covers from 1-90% of the total surface area of said lipophilic base powder and said lipophilic base is selected from silicon resin, silicone rubber and

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silicone resin-covered silicone rubber. Claim 7 specifies the oil component comprises silicone oil. Claim 8 specifies the amount of powder is 1-50% by weight. Claim 9 specifies the composition is an emulsion.

Applicants claim a method of treating rough skin comprising applying the composition to the skin.

Applicants claim a method of treating sensitive skin comprising applying the composition to sensitive skin.

Determination of the scope and the content of the prior art

(MPEP 2141.01)

Nakane et al. teach a composition for protecting skin from the sun comprising; a complex powder including lipophilic base powder and zinc oxide, where the surface of lipophilic base powder is covered with zinc oxide; and an oil component (Example 25). The composition contains 30% zinc oxide covered polymethyl methacrylate (7%) in the form of an emulsion in silicone oil (dimethylpolysiloxane 10%). The lipophilic base powder is dispersed in the oil component (column 26, lines 12-21).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Nakane et al. do not teach a composition comprising the lipophilic base powder selected from the group consisting of silicone resin, silicone rubber and silicone resin-covered-silicone rubber. It is for this reason that Kobayashi et al. is joined.

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Kobayashi et al. teach a cosmetic comprising powdered silicone rubber which has a good feeling and spreading characteristics on the skin (abstract). Using an aqueous suspension of a powdered silicon rubber containing a non-crosslinked oil causes a softening feeling of the skin and improves cosmetic durability wherein the oil impregnates(swells) the powdered silicone rubber (column 3, lines 8-23). It is desirable to have the content of the non-cross-linked oil in the powdered silicone rubber 80% or less, with a content of 50% or less being preferable (column 4, lines 56-63). A powdered silicone rubber whose surface is covered by a fine inorganic powder shows good stability (column 4, lines 64-67). Inorganic powders include zinc oxide (column 5, lines 9, and 21-41).

Finding of prima facie obviousness

Rationale and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Nakane et al. and Kobayashi et al. to further utilize silicone rubber as the base powder. One would have been motivated to use silicon rubber because Kobayashi et al. teach that cosmetics comprising silicone rubber cause softening feeling to the skin and improves cosmetic durability. In view of KSR International Co. v. Teleflex Inc., 550 U.S.--, 82 USPQ2d 1385 (2007), substitution of one known equivalent element for another to obtain predictable results is prima facie obvious. Therefore, one of ordinary skill in the art would have expected that substituting silicone rubber in place of polymethyl methacrylate would yield a cosmetic composition with improved feeling to the skin and durability.

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Claims 1 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (US 5,928,660) in view of Nakane et al. (US 5,122,418).

Applicant's Invention

Applicant claims a complex powder comprising a lipophilic base powder and zinc oxide, where the surface of lipophilic base powder is covered with zinc oxide and an oil component wherein said complex powder is dispersed and swelled in said oil component, the zinc oxide covers from 1-90% of the total surface area of said lipophilic base powder and said lipophilic base is selected from silicon resin, silicone rubber and silicone resin-covered silicone rubber. Claim 7 specifies the oil component comprises silicone oil. Claim 8 specifies the amount of powder is 1-50% by weight. Claim 9 specifies the composition is an emulsion.

Applicants claim a method of treating rough skin comprising applying the composition to the skin.

Applicants claim a method of treating sensitive skin comprising applying the composition to sensitive skin.

Determination of the scope and the content of the prior art (MPEP 2141.01)

Kobayashi et al. teach a cosmetic comprising powdered silicone rubber which has a good feeling and spreading characteristics on the skin (abstract). Using an aqueous suspension of a powdered silicon rubber containing a non-crosslinked oil

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causes a softening feeling of the skin and improves cosmetic durability wherein the oil impregnates(swells) the powdered silicone rubber (column 3, lines 8-23). It is desirable to have the content of the non-cross-linked oil in the powdered silicone rubber 80% or less, with a content of 50% or less being preferable (column 4, lines 56-63). A powdered silicone rubber whose surface is covered by a fine inorganic powder shows good stability (column 4, lines 64-67). Inorganic powders include zinc oxide (column 5, lines 9, and 21-41).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Kobayashi et al. does not teach zinc oxide covers from 1-90% of the total surface area of said lipophilic base powder. It is for this reason that Nakane et al. is joined.

Nakane et al. teach a composition for protecting skin from the sun comprising; a complex powder including lipophilic base powder and zinc oxide, where the surface of lipophilic base powder is covered with zinc oxide; and an oil component (Example 25). The composition contains 30% zinc oxide covered polymethyl methacrylate (7%) in the form of an emulsion in silicone oil (dimethylpolysiloxane 10%). The lipophilic base powder is dispersed in the oil component (column 26, lines 12-21). The amount of zinc oxide covered resin powder is 1-60% to avoid ultraviolet scattering and to improve feel (column 10, lines 58-63).

Finding of prima facie obviousness

Rationale and Motivation (MPEP 2142-2143)

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It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kobayashi et al. and Nakane et al. to include zinc oxide covering 1-90% of the surface of the silicon rubber powder. One would have been motivated to manipulate ranges during routine experimentation to discover the optimum or workable range since Nakane et al. teach that 1-60% zinc covering the resin powder helps to avoid ultraviolet scattering and to improve feel. Hence, it is within the skill of one in the art to adjust the amount of zinc on the surface of a powder to improve feeling on the skin. In view of *KSR International Co. v. Teleflex Inc.*, 550 U.S.--, 82 USPQ2d 1385 (2007), known work in the field of endeavor may prompt variations of it for use in the same field based on design incentives or other market forces if variations would have been predictable to one of ordinary skill in the art. Therefore, one of ordinary skill in the art would have expected that adjusting the amount of zinc oxide would be necessary to avoid ultraviolet scattering and improve feel on the skin when the lipophilic powder is changed from a polymethyl methacrylate to a silicon rubber powder.

Response to Arguments

Applicant's arguments filed 8/27/2009 have been fully considered but they are not persuasive. Applicants argue that Nakane equates the weight percentages when discussing the percentage of covered particles. Applicants further argue that the reference to the core powder being substantially completely covered by one or more organic, inorganic or metallic powders would not motivate an artisan to cover a core powder at a rate anything less than "substantially completely".

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The Examiner is not persuaded by applicant's arguments. First, the Examiner would like to draw Applicants attention to Example 8 wherein the composition comprises (1) titanium dioxide and (2) 35% titanium oxide covered spherical nylon powder. It is clear that these are two distinctly different compounds utilized in the formulation at a relative percentage of 6% and 7%, respectively. The fact that Nakane clearly specifies that (2) is 35% covered with titanium dioxide supports the fact that the surface of the Nylon powder is coated at a specific rate whereas the relative percentage differs for the amount in the overall composition.

Furthermore, the term "substantially completely" is a relative term. The term "substantially completely" is not defined and the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Hence, reliance on this term to teach away from the covering rate is insufficient to overcome the rejection.

Applicant's amendment necessitated the following rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 7-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

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one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended the claims to recite that "the zinc oxide covers from 5 to 50% of the total surface area of said lipophilic base". This recitation is not supported by the specification which only recites the range 1-90%, not 5-50% [0096].

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danielle Sullivan whose telephone number is (571) 270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Danielle Sullivan
Patent Examiner
Art Unit 1616

/Mina Haghighatian/
Primary Examiner, Art Unit 1616